

### REMARKS

Claims 1, 2, 4-6, 11-13, 17-19, 21-25, 35-37, 42, and 56-76 are pending, with claims 1, 65, and 72 being independent. Claims 3, 7-10, 14-16, 20, 26-34, 38-41, and 43-55 were previously cancelled. Claims 1, 42, 65, and 72 have been amended. No new matter has been introduced.

### Claim Rejections - 35 U.S.C. § 101

#### *Independent claims 1 and 65*

Claims 1, 2, 4-6, 11-13, 17-19, 21-25, 35-37, 42, and 56-71 have been rejected for allegedly being directed to non-statutory subject matter. Specifically, the Office Action contends that the recited methods of independent claims 1 and 65 are not (1) tied to a particular machine or apparatus, nor do they (2) transform a particular article into a different state or thing. Independent claim 1, as amended, recites, “inserting, using at least one processor, the first targeted ad item adjacent to the first information item in the channel in the syndicated format.” Independent claim 65, as amended, recites, “generating, using at least one processor and based on the first targeted ad, a first targeted ad item in the syndicated format, the first targeted ad item including a targeted ad title, a targeted ad link, and a targeted ad description.” Support for these amendments can be found in the application at, for example, page 16, lines 15-22 and page 17, lines 25-32, which states that the system 700 includes a processor, e.g., CPU 702.

In view of the amendments to independent claims 1 and 65, more than mere “insignificant extra-solution” steps of amended independent claims 1 and 65 have been tied to another statutory class. Because the amendments to independent claims 1 and 65 “remove[]

issues for appeal,” applicant respectfully requests that the amendments be entered by the Office. *See* MPEP § 714.13(II). Accordingly, in view of the amendments to claims 1 and 65, applicant respectfully requests reconsideration and withdrawal of this rejection of amended independent claims 1 and 65 and their dependent claims as being directed to non-statutory subject matter.

*Independent claim 72*

Claims 72-76 have been rejected for allegedly being directed to non-statutory subject matter. Specifically, the Office Action contends that the recited system of independent claims 72 “must be distinguishable over the prior art in terms of [its] structure” and that “[i]t is not clear that the instant claims embody any structure.” Independent claim 72 recites a “system comprising one or more processors connected to one or more storage devices” and, as such, recites structure.

Moreover, the system is “configured to” perform the functionality recited in independent claim 72. As described in greater detail below, none of the cited art describes or suggests a system that is configured to perform the functionality of independent claim 72.

Finally, “computer storage medium” has been replaced with “one or more storage devices.” Because the amendment to independent claim 72 “removes issues for appeal,” applicant respectfully requests that the amendment be entered by the Office. *See* MPEP § 714.13(II). Accordingly, for at least these reasons, applicant respectfully requests reconsideration and withdrawal of this rejection of amended independent claim 72 and its dependent claims as being directed to non-statutory subject matter.

Claim Rejections - 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph

Claims 1, 2, 4-6, 11-13, 17-19, 21-25, 35-37, 42, and 56-76 have been rejected as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Specifically, the Office Action contends that particular terms in claims 1, 2, 11, 22, 23, 56, and 65-67 are not supported by the specification. Applicant respectfully disagrees for the reasons noted below.

With regard to independent claim 1, support for “a first information item of a channel” can be found throughout the application, such as, for example, at FIG. 16 and the accompanying text. Independent claim 1 has been amended to recite a “computer storage device,” which is supported throughout the application, such as, for example, at FIG. 7 and the accompanying text.

With regard to claim 2, support for a “syndicated format [being] configured to list at least one item having a title, a link, and a description corresponding to a channel” can be found throughout the application, such as, for example, at FIG. 16 and the accompanying text.

With regard to claim 11, support for “generating the first targeted ad item in the syndicated format based on the first targeted ad” can be found throughout the application, such as, for example, at page 13, lines 22-25.

With regard to claim 22, support for “a geographic location to which the channel is forwarded” can be found throughout the application, such as, for example, at page 11, line 28 to page 12, line 14.

With regard to claim 23, support for “generating a second targeted ad item,” “inserting the second targeted ad item adjacent to the second information item in the channel in the syndicated format,” and “forwarding the channel including the first information item, the second

information item, the first targeted ad item, and the second targeted ad item” can be found throughout the application, such as, for example, at FIG. 16 and the accompanying text.

With regard to claim 56, support for “the first information item in the channel” can be found throughout the application, such as, for example, at FIG. 16 and the accompanying text.

With regard to independent claim 65, support for a “generating ... a first targeted ad item in the syndicated format” and “to generate a channel” can be found throughout the application, such as, for example, at FIG. 16 and the accompanying text.

With regard to claim 66, support for “receiving a first targeted ad including the at least one keyword” can be found throughout the application, such as, for example, at FIG. 9 and the accompanying text.

With regard to claim 67, support for “the syndicated information/ad mixer being different from the user system and the search/content server” can be found throughout the application, such as, for example, at FIG. 1 and the accompanying text.

Accordingly, because all of the subject matter of claims 1, 2, 11, 22, 23, 56, and 65-67 is supported by the specification and because the scope of these claims is clear, applicant respectfully requests reconsideration and withdrawal of this rejection of claims 1, 2, 11, 22, 23, 56, and 65-67. *See* MPEP § 2173 (“The primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent.”).

The Office Action contends that claim 42 contains an improper Markush group. Claim 42, as amended, recites “one keyword included in a user request, a user profile information, or geographic location information,” which is proper according to MPEP § 2173.05(h)(II). Because

the amendment to claim 42 “removes issues for appeal,” applicant respectfully requests that the amendment be entered by the Office. *See* MPEP § 714.13(II). Accordingly, in view of the amendment to claim 42, applicant respectfully requests reconsideration and withdrawal of this rejection of claim 42.

The Office Action contends that the specification does not disclose whether the “syndicated content provider system” of claim 62 is a business entity or a machine or apparatus. Applicant respectfully disagrees. The specification, on page 16, lines 15-22, states that the syndicated content provider system 110 can be a system, such as the system 700. Accordingly, for at least these reasons, applicant respectfully requests reconsideration and withdrawal of this rejection of claim 62.

#### Claim Rejections - 35 U.S.C. § 102

Claims 1, 2, 4-6, 11-13, 17-19, 23-25, 35-37, 42, and 56-76 have been rejected as being anticipated by Sheth (U.S. Patent No. 6,311,194).

#### *Independent claims 1 and 72*

Independent claim 1 recites, in part, receiving a first information item of a channel in a syndicated format, the first information item including a first title, a first link, and a first description, the channel including a channel title, a channel link, and a channel description; receiving a first targeted ad item in the syndicated format, the first targeted ad item including a first targeted ad title, a first targeted ad link, and a first targeted ad description; and inserting, using at least one processor, the first targeted ad item adjacent to the first information item in the channel in the syndicated format.

Sheth discloses two forms of semantic advertising. *See* Sheth at col. 16, lines 5-6. The first type involves an internal database of advertisements. *See* Sheth at col. 16, lines 6-10. The second type involves sending user queries in an XML string to an external advertisement provider. *See* Sheth at col. 16, lines 37-42. The external advertisement provider then returns a URL reference to a semantically targeted advertisement. *See* Sheth at col. 16, lines 42-44. When a user chooses to play an audio or video file in a query result, a player for the media as well as an additional Web browser including the targeted advertisement is created. *See* Sheth at col. 16, lines 46-55.

Therefore, because Sheth discloses sending only user queries that are used to select an advertisement in an XML string, Sheth does not describe or suggest receiving or processing an information item in a syndicated format. The Office Action contends that “syndicated format” is non-functional descriptive material and does not give “syndicated format” patentable weight. Moreover, the Office Action does not give “the first information item including a first title, a first link, and a first description,” “the channel including a channel title, a channel link, and a channel description,” or “the first targeted ad item including a first targeted ad title, a first targeted ad link, and a first targeted ad description” patentable weight.

Applicant respectfully submits that “syndicated format” and the features of the first information item, the channel, and the first targeted ad item be given patentable weight because the first information item, the channel, and the first targeted ad item in the syndicated format are functionally interrelated to the statutory method of independent claim 1, as previously explained in the Remarks filed December 29, 2008. *See, generally, In re Miller*, 418 F.2d 1392, 1396, 164 USPQ 46, 48-49 (CCPA 1969) (“The fact that printed matter by itself is not patentable subject

matter, because non-statutory, is no reason for ignoring it when the claim is directed to a combination.") (emphasis added); *see also* MPEP § 2106.01(II) ("Nonfunctional descriptive material may be claimed in combination with other functional descriptive multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. 101.").

In response to the Remarks filed December 29, 2008, the Office Action gives three reasons why no patentable weight is given to "syndicated format" and the features of the first information item, the channel, and the first targeted ad item. First, the Office Action contends that independent claim 1 is not statutory. Applicant respectfully submits that the independent claim 1, as amended, is statutory for the reasons discussed above in connection with the 35 U.S.C. § 101 rejection.

Second, the Office Action contends that both the first information item and the first targeted ad item are non-functional descriptive material. However, regardless of whether the first information item and the first targeted ad item are or are not non-functional descriptive material, they must be given patentable weight because independent claim 1 is directed to a statutory method for the reasons explained above.

Third, the Office Action contends that the first information item and the first targeted ad item cannot be functionally related because of the syndicated format. Applicant respectfully disagrees. First, independent claim 1 recites receiving the first information item and the first targeted ad item in the syndicated format. Second, independent claim 1 further recites inserting the first targeted ad item adjacent to the first information item in the channel in the syndicated format. Therefore, the characteristics and relationship between the first information item and the

first targeted ad item are necessarily a result of both items and the channel being in the syndicated format.

Finally, the Office Action contends that the specification does not include a clear definition for "channel." Applicant respectfully disagrees. The specification, on page 2, lines 27-32, states that "[t]he list of discrete items is sometimes known as a channel," and shows multiple examples of channels at least in connection with FIGS. 8-16.

Accordingly, for at least these reasons, applicant respectfully requests reconsideration and withdrawal of this rejection of amended independent claim 1 and its dependent claims.

Amended independent claim 72 recites subject matter that is similar to that discussed above in connection with amended independent claim 1, and does so in the context of a system. Accordingly, at least for the reasons discussed above in connection with amended independent claim 1, applicant respectfully requests reconsideration and withdrawal of the rejection of amended independent claim 72 and its dependent claims.

*Independent claim 65*

Independent claim 65 recites, in part, receiving, in response to at least one keyword, first information; generating, based on the first information, a first information item in a syndicated format, the first information item including a first title, a first link, and a first description; receiving, in response to the at least one keyword, a first targeted ad; generating, using at least one processor and based on the first targeted ad, a first targeted ad item in the syndicated format, the first targeted ad item including a targeted ad title, a targeted ad link, and a targeted ad description; and inserting the first targeted ad item adjacent to the first information item to generate a channel including the first information item and the first targeted ad item in the



syndicated format, the channel including a channel title, a channel link, and a channel description.

Applicant respectfully submits that amended independent claim 65 is allowable for reasons discussed above in connection with amended independent claim 1.

Moreover, the Office Action equates the XML string of Sheth to the recited first information, and the individual media assets of Sheth to the recited first information item, which is generated based on the first information. Sheth discloses creating an XML string that represents queries that the user performs or individual media assets in which the user has an interest. *See* Sheth at col. 16, lines 37-40. As such, Sheth discloses that the XML string can represent individual media assets, but does not describe or suggest that the individual media assets are generated based on the XML string.

In addition, Sheth does not disclose that the individual media assets are included in a channel adjacent to a first target ad item. Accordingly, for at least these reasons, applicant respectfully requests reconsideration and withdrawal of this rejection of amended independent claim 65 and its dependent claims.

*Claims 11-13, 17, 19, and 23-25*

The Office Action rejects claims 11-13, 17, 19, and 23-25 as a group, instead of individually, ignoring the differences in scope and recited features between claims 11-13, 17, 19, and 23-25. Applicant notes that an omnibus rejection, like the rejection of claims 11-13, 17, 19, and 23-25, is disfavored because it fails to provide the applicant with any guidance or a fair opportunity to reply:

An omnibus rejection . . . is stereotyped and usually not informative and should therefore be avoided. This is especially true where certain claims have been rejected on one ground and other claims on another ground. A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.

MPEP § 707.07(d) (emphasis added); *see also* MPEP § 706.02(j) (“It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.”).

Accordingly, for at least the foregoing reasons, applicant submits that the final Office Action is incomplete and fails to establish that Sheth anticipates all of the features of claims 11-13, 17, 19, and 23-25.

In the absence of a withdrawal of the rejection of claims 11-13, 17, 19, and 23-25 and a reopening of prosecution on the merits, applicant requests, at the very least, issuance of a new Office Action that clearly articulates the grounds for rejection of claims 11-13, 17, 19, and 23-25 and that shows how each of the features of claims 11-13, 17, 19, and 23-25 is believed to be met, so that applicant has a “fair opportunity to reply” to the rejection and so that the issues are properly framed for appeal. *See* MPEP § 706.02(j).

For example, claim 23 recites “receiving a first targeted ad selected based on content included in the first information item;” “generating the first targeted ad item in the syndicated format based on the first targeted ad;” “receiving a second information item of the channel in the syndicated format, the second information item including a second title, a second link, and a second description, the second information item being different from the first information item;” “receiving a second targeted ad selected based on content included in the second information item, the second targeted ad being different from the first targeted ad;” “generating a second

targeted ad item in the syndicated format based on the second targeted ad, the second targeted ad item including a second targeted ad title, a second targeted ad link, and a second targeted ad description;” and “inserting the second targeted ad item adjacent to the second information item in the channel in the syndicated format, wherein forwarding the channel comprises forwarding the channel including the first information item, the second information item, the first targeted ad item, and the second targeted ad item.” The applicant respectfully requests that the Office show how each of the features of claim 23 is believed to be met by Sheth.

*Claims 42, 56, 62-64, 66, and 67*

The Office Action also rejects claims 42, 56, 62-64, 66, and 67 as a group, instead of individually, ignoring the differences in scope and recited features between claims 42, 56, 62-64, 66, and 67. For the reasons discussed above, applicant notes that an omnibus rejection, like the rejection of claims 42, 56, 62-64, 66, and 67, is disfavored. Accordingly, applicant submits that the final Office Action is incomplete and fails to establish that Sheth anticipates the all of the features of claims 42, 56, 62-64, 66, and 67.

In the absence of a withdrawal of the rejection of claims 42, 56, 62-64, 66, and 67 and a reopening of prosecution on the merits, applicant requests, at the very least, issuance of a new Office Action that clearly articulates the grounds for rejection of claims 42, 56, 62-64, 66, and 67 and that shows how each of the features of claims 42, 56, 62-64, 66, and 67 is believed to be met, so that applicant has a “fair opportunity to reply” to the rejection and so that the issues are properly framed for appeal.

*Claims 2, 4-6, 18, 35-37, 57-61, 68-71, and 73-76*

The Office Action also rejects claims 2, 4-6, 18, 35-37, 57-61, 68-71, and 73-76 as a group, instead of individually, ignoring the differences in scope and recited features between claims 2, 4-6, 18, 35-37, 57-61, 68-71, and 73-76. In addition, the Office Action ignores the features of claims 2, 4-6, 18, 35-37, 57-61, 68-71, and 73-76 as being directed only to non-function descriptive material.

For the reasons discussed above, applicant notes that an omnibus rejection, like the rejection of claims 2, 4-6, 18, 35-37, 57-61, 68-71, and 73-76, is disfavored because it fails to provide the applicant with any guidance or a fair opportunity to reply. In addition, applicant notes that all of the features of claims 2, 4-6, 18, 35-37, 57-61, 68-71, and 73-76 are functionally interrelated to the statutory methods of independent claims 1 and 65, and the system of independent claim 72.

Accordingly, for at least the foregoing reasons, applicant submits that the final Office Action is incomplete and fails to establish that Sheth anticipates the all of the features of claims 2, 4-6, 18, 35-37, 57-61, 68-71, and 73-76. In the absence of a withdrawal of the rejection of claims 2, 4-6, 18, 35-37, 57-61, 68-71, and 73-76 and a reopening of prosecution on the merits, applicant requests, at the very least, issuance of a new Office Action that clearly articulates the grounds for rejection of claims 2, 4-6, 18, 35-37, 57-61, 68-71, and 73-76 and that shows how each of the features of claims 2, 4-6, 18, 35-37, 57-61, 68-71, and 73-76 is believed to be met, so that applicant has a "fair opportunity to reply" to the rejection and so that the issues are properly framed for appeal.

Claim Rejections - 35 U.S.C. § 103

Claims 21 and 22 have been rejected as being unpatentable over Sheth in view Official Notice. The Office Action acknowledges that “Sheth does not teach targeting ads by geography.” Instead, the Office Action takes official notice with respect to these limitations by conclusorily stating that “this was a common means of targeting ads at the time of the instant invention.” However, “[i]t is never appropriate to rely solely on ‘common knowledge’ in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based.” See MPEP § 2144.03(B) (citing *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (emphasis added).

Therefore, to the extent that this rejection is maintained, applicant again traverses the official notice taken and request evidentiary support demonstrating the contention that targeting ads by geography or a link “was a common means of targeting ads at the time of the instant invention.” See MPEP § 2144.03 (“If applicant adequately traverses the examiner’s assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained.”).

Accordingly, for at least these reasons, applicant respectfully requests reconsideration and withdrawal of the rejection of claims 21 and 22.

Conclusion

Applicant submits that all claims are in condition for allowance.

It is believed that all of the pending issues have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be

exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this reply should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this reply, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

No fee is believed to be due in connection with the filing of this paper on the Electronic Filing System (EFS). In the event that any fees are due, please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: May 12, 2009

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